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Patent
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Jennifer D. Adamson

Date: May 14, 2003

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

In re application of)	
)	
)	
ANDREW JOHN HOLMES and)	
CAMERON WILLIAM WATSON)	
)	
Serial No. 09/648,325)	Group Art Unit 1764
)	
Filed August 25, 2000)	Examiner J. D. Johnson
)	
HYDRAULIC FLUID)	May 14, 2003
)	

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANT'S BRIEF

The following brief is on appeal of a final rejection of claims 1 and 4-6 of the above-identified U.S. patent application. The final rejection was contained in an Office Action mailed on Nov. 14, 2002, and a Notice of Appeal was mailed by Applicant on Feb. 14, 2003. This brief is filed in triplicate. Please charge the fee for filing of this brief to Shell Oil Company Deposit Account No. 19-1800. It is respectfully requested that the Board consider

the following arguments and reverse the final rejection of claims 1 and 4-6 in the above-identified application. A petition for a one-month extension of time accompanies this Brief.

REAL PARTY IN INTEREST

The invention of the present application is assigned to Shell Oil Company, which is the real party of interest in the present appeal.

RELATED APPEALS AND INTERFERENCES

Appellants, and appellants' legal representative, are not aware of any appeals or interferences that directly affect or could directly be affected by or have a bearing on the Board's decision in the present appeal.

STATUS OF THE CLAIMS

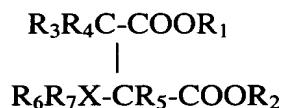
Claims 1 and 4-6 stand finally rejected under 35 U.S.C. §103(a). Rejection of Claims 1 and 4-6 is presently appealed.

STATUS OF AMENDMENT

No amendments were requested after the Office Action of Nov. 14, 2002.

SUMMARY OF THE INVENTION

The invention is a hydraulic fluid containing a combination of magnesium salicylate, zinc dithiophosphate and a compound having the following formula:



in which R_1 and R_2 are each hydrogen or alkyl or hydroxyalkyl of 1 to 30 carbon atoms; R_3 , R_4 and R_5 are each hydrogen or alkyl or hydroxyalkyl of 1 to 4 carbon atoms; X is CH or N and R_6 and R_7 are each hydrogen, alkyl or alkenyl of 1 to 30 carbon atoms, or an acyl group derived from a saturated or unsaturated carboxylic acid of up to 30 carbon atoms.

ISSUES

- 1) Does Denis *et al*, US Patent 4,954,273 ('273) provide a *prima facie* basis for rejection of claims 1 and 4-6 under 35 U.S.C. §103(a)?

- 2) Does Matthews *et al*, US 4,462,918 ('918) in view of EP 0 434 464 A1, ('464) and Karn, US 4,627,928 ('928) provide a *prima facie* basis for rejection of claims 1 and 4-6 under 35 U.S.C. §103(a)?
- 3) Does Fujitsu *et al*, US Patent 6,114,288 ('288) in view of the '918 reference provide a *prima facie* basis for rejection of claims 1 and 4-6 under 35 U.S.C. §103(a)?

GROUPING OF CLAIMS

The claims stand or fall together.

ARGUMENTS

1) Rejection of Claims 1 and 4-6 over the '273 Reference

To establish a *prima facie* basis for obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure [MPEP § 2142; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).]

The '273 reference addresses water tolerance, anti-wear and pH stability issues in crank case oils by adding overbased salts of iso-stearylpentapentaethyleneglycolacetic acid to the oil (col. 5, lines 5-11). The reference further discloses that the overbased salts of the invention have particularly good results when included within fully formulated crank case oil package concentrates. Additives mentioned in the reference as being part of a fully formulated crank case oil include VI improvers, zinc dithiophosphate compounds, polyol dispersants and calcium or magnesium salicylate. There is no teaching or suggestion in this reference that would lead one of ordinary skill in the art to the combination of a zinc

dithiophosphate, magnesium salicylate and an ester of a carboxylic acid in a hydraulic fluid in order to improve thermal stability without increased wear at the claimed weight percentages (instant application page 3, lines 27-32 and page 4 lines 1-3). Therefore, there is no suggestion or motivation to modify the reference to arrive at Applicants' current invention. Because this is lacking, a *prima facie* case for obviousness has not been established.

2) Rejection of Claims 1 and 4-6 over the '918 Reference in view of the '464 and '928 References

The '918 reference discloses a hydraulic fluid with improved wear resistance containing a metal dithiophosphate and an ester of a carboxylic acid according to the formula of the instant invention. However, the reference does not teach or suggest the addition of magnesium salicylates to the composition disclosed. The Examiner asserts that a teaching or suggestion for this component may be found in the combination of the '464 and the '928 references. The '464 reference teaches the addition to a hydraulic fluid of an overbased alkyl salicylate, with no specific suggestion for the addition of magnesium salicylate as opposed to any other alkaline earth metal salicylate, as well as the addition of an amino ester of a carboxylic acid according to the formula of the instant invention. However, this reference relates to hydraulic fluids that are zinc free (page 2, line 9) and emphasizes that an important advantage of the invention is that it does not include transition metal compounds, and further discloses that hydraulic fluids containing such compounds do not always perform according to required specifications. Therefore, the '464 reference teaches away from arriving at a combination of additives that includes a zinc dithiophosphate. Thus, one of ordinary skill in the art would not be motivated to combine the disclosure of the '464 reference with the '918 reference. The '928 reference relates to synthesis of basic magnesium salts of alkylated aromatic hydroxy-

containing carboxylic acids. There is no teaching or suggestion in this reference to combine it with the teachings of the '464 and '918 references in order to arrive at the current claimed composition. Because these references lack any suggestion to modify them in a manner that would arrive at the instant invention, a *prima facie* case for obviousness has not been established.

3) Rejection of Claims 1 and 4-6 over the '288 Reference in view of the '918 Reference

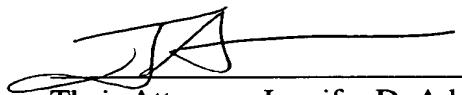
The '288 reference discloses adding a zinc dialkyldithiophosphate and magnesium salicylate to a motor oil. An ester of a carboxylic acid is neither taught nor suggested. The '918 reference discloses adding a Group II metal dithiophosphate and an ester of a carboxylic acid to hydraulic fluid. There is no teaching or suggestion in the '918 reference that would lead the person of ordinary skill in the art to combine it with the '288 reference by adding magnesium salicylate to the composition. As there is no teaching nor suggestion to combine these references, a *prima facie* case for obviousness has not been made.

CONCLUSION

For the reasons set forth above, Applicants assert that the rejections made by the Examiner are improper. Applicants therefore respectfully request that the Board reverse the Examiner's rejections.

Respectfully submitted,

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